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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,084	04/27/2001	Oliver Nickel	Beiersdorf 721-KGB	9701

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EXAMINER

SALVATORE, LYNDIA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/19/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/844,084

Applicant(s)

NICKEL, OLIVER

Examiner

Lynda M Salvatore

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-- **The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Specification***

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (d) BRIEF SUMMARY OF THE INVENTION.
- (e) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (f) DETAILED DESCRIPTION OF THE INVENTION.
- (g) CLAIM OR CLAIMS (commencing on a separate sheet).
- (h) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 is further rejected for its dependency on claim 1.

5. Claim 1 is indefinite for the recitation of "is capable". It is unclear to the Examiner what the Applicant would view as masking material. The Applicant needs to positively recite the structural and/or chemical features of the masking material rather than setting forth what the material "is capable" of. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138

6. Claim 2 is indefinite for the recitation of "so-called". It is unclear to the Examiner what the Applicant means by the use of this term. The Examiner suggests reciting "said masking tape having a heat resistance, etc." In addition, claim 2 is indefinite because it is unclear to the Examiner if the "adhesive tape" and the "so-called masking tape" are one in the same or if the "adhesive tape" recited in part (a) of claim 1 makes up the "so-called" heat resistant masking tape. Also, claim 2 recites the limitation of "automobile painter" in line 2. There is insufficient antecedent basis for this limitation in the claim. Additionally, claim 2 is further indefinite because it is unclear to the Examiner if the (1 hour) in parenthesis is supposed to be representative of a required duration of time at the claimed specified temperature. If so, the Examiner suggests positively reciting this limitation.

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7. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 2-6 and 8 recites a broad recitation followed by narrower limitation statement of the range/limitation.

8. Claim 4 is indefinite because of the term "good". The term "good" is a relative term which renders the claim indefinite. The term "good" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

9. Claims 2-8 and 10 are indefinite because of the use of the terms "especially", "in particular", and "particularly". Preferences should not be set forth in the claims because the intended scope of the claim is unclear. See MPEP 2173.05 (d).

***Claim Rejections - 35 USC § 103***

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeuwenburgh, US 5,935,669 in view of Akimoto et al., US 4,358,494.

The Patent issued to Leeuwenburgh discloses a cover sheet for protection of paint splatter, which is suitable for doors, windows, walls, or automobile parts (Column 3, 37-40). The cover sheet comprises a 15-25mm in width adhesive tape and an 8-10  $\mu$ m widthwise plastics material sheet, which is folded lengthwise with seven longitudinally extending folds (Column 3, 45-50, 60-63). The adhesive tape is longitudinally adhered to the plastic sheet in an overlapping fashion by 3-5mm of its width so that it projects beyond the longitudinal edge portion (Column 3, 3-9 and 63-67). The adhesive tape comprises an adhesive crepe tape and a crepe tape cover strip (Column 4, 5-8). The adhesive tape and the cover strip together have a thickness of about 250  $\mu$ m (Column 4, 8-11). As illustrated in Figure 1 the plastics material sheet and adhesive tape is folded in a roll and the height of the roll corresponds to the approximate width of the masking material/adhesive tape combination.

Leeuwenburgh fails to teach adhering a masking material having a masking covering sheet to the adhesive tape, however, the patent issued to Akimoto et al., discloses a paper backed pressure-sensitive adhesive tape comprising a sheet of bleached or unbleached kraft paper (Column 3, 35-40, 55 and Column 6, 63-64), a widthwise stretched high density polyethylene film, having a thickness of 10-50  $\mu$ m (Column 4, 1-7), an adhesive layer to lap seal the film onto

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the backing layer (Column 3, 37-38), a polyethylene release layer over the stretched film (Column 3, 40-42), and a pressure sensitive adhesive layer over the kraft paper layer (Figure 1). A corona discharge pre-treatment may be used to anchor the adhesive layer and the release layer (Column 3, 38-48). Akimoto et al., teaches that paper backed adhesive tapes exhibit improved lap sealing properties, slip resistance, unwind ability, widthwise strength and when combined with a stretched film, easy widthwise tearing properties (Column 2, 3-6, 64-69).

With regards to the heat-resistant limitations present in claims 1 and 2, it is reasonable to presume that this property is inherent to the creped adhesive tape structure of the Leeuwenburgh. Since the Applicant fails to set forth the structural and/or chemical properties of the adhesive tape, which would produce the heat resistant properties, it is the position of the Examiner that the creped adhesive tape of Leeuwenburgh is structurally and chemically equivalent to the adhesive tape of the instant invention and thus would have the claimed heat resistant properties. The burden is upon the Applicant to substantiate the claimed heat resistant properties.

Therefore, motivated to provide a masking tape material having improved sealing, slip resistance, strength and tearing properties, it would have been obvious to one having ordinary skill in the art at the time the invention was made to longitudinally adhere the paper backed pressure sensitive adhesive tape of Akimoto et al., to the adhesive tape material of Leeuwenburgh.

With respect to the weight of the kraft paper, Akimoto discloses the weight as  $73 \text{ g/m}^2$ , however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the weight of the kraft paper as a function of the desired intended use. It has been held that where the general conditions of a claim are disclosed in the

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prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.


***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070.

The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

ls   
December 16, 2002

  
CHERYL A. JUSKA  
PRIMARY EXAMINER